

## **REMARKS:**

### **Status Of Claims**

Claims 1-21 were previously pending, claims 1, 6, 12, 19, and 20 have been amended, and claims 8 and 17 have been cancelled. Thus, claims 1-7, 9-16, and 18-21 are currently pending in the application with claims 1, 12, 20, and 21 being independent.

### **Office Action**

Applicant would like to thank the Examiner for indicating that claim 21 is allowable. In the office action, the Examiner rejected claims 1 and 7 under 35 U.S.C. 102(b) as being anticipated by Trombly, U.S. Patent No. 4,630,744. The Examiner also rejected claims 1, 2, and 4-8 under 35 U.S.C. 102(b) as being anticipated by Martinot, U.S. Patent No. 438,931. The Examiner also rejected claim 3 under 35 U.S.C. 103(a) as being unpatentable over Martinot in view of MacLeod, U.S. Patent No. 3,286,711. The Examiner also rejected claims 9, 12, 13, and 15-19 under 35 U.S.C. 103(a) as being unpatentable over Martinot in view of Claycomb et al., U.S. Patent No. 3,378,004. The Examiner also rejected claims 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Martinot. The Examiner also rejected claims 14 and 20 under 35 U.S.C. 103(a) as being unpatentable over Martinot in view of Claycomb et al., in further view of MacLeod. Applicant respectfully asserts that all of the currently pending claims distinguish the present invention from the prior art references of record.

Specifically, claim 1 now recites "a series of bumps aligned on a non-slip plastic coating which forms an annular ring around an exterior surface of the sidewall". Similarly, claim 19 now recites "wherein the apparatus further includes a gripping element ... comprising a series of bumps which form an annular ring around an exterior surface of the sidewall". As stated beginning on page 6, line 29, and continuing through page 7, line 6, "a gripping element 30 [may be] positioned on an exterior surface 32 of the sidewall. ...

The gripping element 30 may be a series of bumps aligned on a non-slip plastic coating which forms an annular ring around the exterior surface 32".

In contrast, none of the prior art references of record shows such structure. Specifically, in rejecting claim 8, which included a gripping element limitation, the Examiner asserted that Martinot's strap could be construed as a gripping element. Such a strap is certainly not equivalent to the series of bumps now recited in claims 1 and 19. Furthermore, as disclosed in lines 38-42, Martinot's strap is designed to "secure the receptacle upon the bather's limb". Therefore, replacing Martinot's strap with the bumps recited in claims 1 and 19 would not accomplish the function of Martinot's strap. Thus, neither Martinot nor the other prior art references of record discloses, suggests, or makes obvious "a series of bumps" "which forms an annular ring around an exterior surface of the sidewall", as claimed in claims 1 and 19.

Claim 2 recites "wherein the apparatus further comprises a cleaning element positioned within the sidewall". Claim 6 depends from claim 2 and now recites "wherein the cleaning element is removable from the apparatus, such that the cleaning element may be removed and repositioned along an interior surface of the sidewall". Similarly, claim 12 now recites "a cleaning element [which] may be removed and repositioned along an interior surface of the sidewall". As stated on page 7, lines 7-25, "[t]he cleaning element 20, or portions thereof, may be removably or permanently attached to the apparatus 10 or the interior surface 26 ... and may be removably attached to the apparatus 10 or interior surface 26 through the connecting element, hooks, latches, or other means so that it may be removed, cleaned, and reinserted in the apparatus 10". Thus, according to the limitations of claims 6 and 12, the cleaning element may be removed, such as for cleaning, and then repositioned along the interior surface of the sidewall.

In contrast, the Examiner asserted that "the teats 11 of Martinot are capable of being removed as by cutting or grinding". Surely removing Martinot's teats in this

manner would destroy them and prohibit them from being "repositioned along an interior surface of the sidewall", as claimed in claims 6 and 12. Thus, neither Martinot nor the other prior art references of record discloses, suggests, or makes obvious a cleaning element which "may be removed and repositioned along an interior surface of the sidewall", as claimed in claims 6 and 12.

Claims 11 and 18 each recite "wherein at least a portion of the apparatus is substantially transparent to allow the paw to be viewed through the apparatus". In rejecting these claims as obvious, the Examiner asserted "the use of a transparent material in its construction would have been obvious to one skilled in the art wishing it to ... permit viewing of an inserted foot (or paw) during the bathing process". Applicant respectfully traverses and requests proof that the limitations of claims 11 and 18 are obvious.

Furthermore, with regard to the obviousness rejections of claims 3 and 9-20, the Examiner has simply not properly established a *prima facie* case of obviousness. Specifically, the Examiner has not cited references that teach all of the claim limitations, nor has the Examiner cited prior art that suggests the desirability of the modification.

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP § 2142 places upon the Examiner the initial burden of establishing a *prima facie* case which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine reference teachings. If the Examiner fails to establish the requisite *prima facie* case, the

rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

The Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984). Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 1442 (Fed. Cir. 1991). Thus, measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

In the present case, the Examiner has not cited prior art that shows an apparatus for cleaning an animal's paw "wherein at least a portion of the apparatus is substantially transparent to allow the paw to be viewed through the apparatus", as claimed in claims 11 and 18. Furthermore, the Examiner only asserted, as the required suggestion or motivation to combine, the desirability stated in the present application. For example, as stated on page 8, lines 20-22, "the user may view the paw's position in the apparatus 10 and monitor the cleaning process to ensure that the paw is sufficiently cleaned".

In contrast, as discussed above, the suggestion or motivation to make the claimed combination must be found in the prior art and not based on the applicant's disclosure. Thus, the Examiner's asserted desirability is simply impermissible hindsight and, absent a supporting reference, cannot be used to reject claims 11 and 18.

Similarly, claims 3 and 14 each recite "wherein the cleaning element comprises a sponge operable to scour the animal's paw". In rejection claims 13 and 14, the Examiner asserts that MacLeod stands for the proposition "that a sponge positioned about the inner sidewall of a fluid container permits a sealable fit with an inserted limb". However, while MacLeod does disclose a sealing fit to an arm, MacLeod does not even use the word "sponge". Furthermore, MacLeod's seal, to which the Examiner points, does not perform any cleaning function. Rather, MacLeod's seal simply seals. Therefore, MacLeod does not disclose "a sponge operable to scour the animal's paw", as claimed in claims 3 and 14. Thus, MacLeod does not stand for the asserted proposition and cannot properly support the Examiner's rejection.

In summation, with regard to the obviousness rejections of claims 3 and 9-20, the Examiner has simply not properly established a *prima facie* case of obviousness. As the Examiner has not cited references that teach all of the claim limitations or suggest the desirability of the modification, these rejections cannot be sustained.

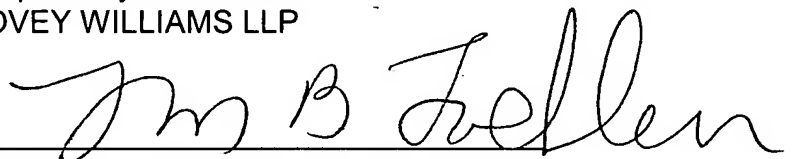
Claim 20 is essentially a combination of the limitations discussed above and

is therefore also allowable. The remaining claims all depend directly or indirectly from independent claim 1 and 12 are therefore also allowable. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 19-0522.

Respectfully submitted,  
HOVEY WILLIAMS LLP

By:

A handwritten signature in black ink, appearing to read "T B Luebbering", written over a horizontal line.

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